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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/685,398	10/10/2000	James Richard Kraemer	RSW9-2000-0107-US1	7911

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EXAMINER
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HAMILTON, LALITA M

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/685,398

Applicant(s)

KRAEMER, JAMES RICHARD

Examiner

Lalita M Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3</u> . | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 6-9, 15-16, 21-22, and 28-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Shearer (US 2002/0002521).

Shearer discloses a load aware optimization system and method for rebalancing portfolios comprising transmitting an alert message for alerting an imbalance status of a customer's portfolio, and a list of recommended rebalancing transactions, to a customer, receiving a single response of the customer to the transmitted alert message, and automatically implementing the list of recommended rebalancing transactions based on the received customer's response (claim 1—p.1, 8 and p.6, 46-48); verifying the identify of the customer prior to the implementing step (claim 6--It is inherent that the customer will be automatically identified by the system in order to prevent unauthorized access to the customer's account information); the verifying step is performed automatically by a computer system (claim 7-- It is inherent that the customer will be automatically identified by the system in order to prevent unauthorized access to the customer's account information); the alert message is generated based on an alert level set by the

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customer (claim 8-- p.1, 8 and p.6, 46-48); generating execution instructions based on the list of recommended rebalancing transactions and transmitting the execution instructions to an electronic trading system, whereby the list of recommended rebalancing transactions are electronically executed (claim 9-- p.1, 8; p.2, 21; and p.6, 46-48); in the receiving step, the customer's responses is received from a computer of the customer using a financial program installed on the computer (claim 15-- p.1, 8 and p.6, 46-48); a system of rebalancing a portfolio of assets to achieve optimality, the system comprising a first unit for determining an imbalance status of a customer's portfolio and preparing an alert message to alert the customer and a list of recommended rebalancing transactions that optimizes the portfolio and a second unit for transmitting the alert message and the list of recommended rebalancing transactions to the customer, receiving a single response of the customer to the transmitted alert message, and automatically implementing the list of recommended rebalancing transactions based on the received customer's response (claim 16-- p.1, 8 and p.6, 46-48); the second unit verifies the identify of the customer prior to implementing the list of recommended rebalancing transactions (claim 21-- It is inherent that the customer will be automatically identified by the system in order to prevent unauthorized access to the customer's account information); to implement the list of recommended rebalancing transactions, the second unit generates execution instructions based on the list of recommended rebalancing transactions and transmits the execution instructions to an electronic trading system, whereby the list of recommended rebalancing transactions are electronically executed (claim 22-- p.1, 8; p.2, 21; and p.6, 46-48); the second unit

receives the customer's response which is transmitted from a computer of the customer using a financial program installed on the computer (claim 28-- p.1, 8 and p.6, 46-48); a computer-implemented method of addressing a certain status of an item, the method comprising the steps of monitoring a current status of the item based on user-defined parameters, automatically triggering transmission of an alert message to a user based on the user defined parameters if the current status of the item has shifted to a second status, receiving a single response of the user to the alert message, and automatically performing a plurality of predetermined actions in response to the single response from the user (claim 29-- p.1, 8 and p.6, 46-48); the triggering step, a list of the predetermined actions is transmitted to the user along with the alert message (claim 30-- p.1, 8 and p.6, 46-48); and the item involves a portfolio of assets, and the performing step optimizes the portfolio (claim 31-- p.1, 8 and p.6, 46-48).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-5, 10-14, 17-20, and 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shearer in view of Masand (US 2002/0095362).

Shearer discloses the invention substantially as claimed; however, Shearer does not disclose the transmitting step is performed via a first customer-defined communications method; automatically transmitting the alert message and the list of

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recommended rebalancing transactions to the customer via a second customer-defined communications method if the step of transmitting via the first communications method was not successfully executed; the customer's response constitutes performing a single action by the customer; the single action comprises one of the following: pressing a button, touching a portion of a screen, or speaking a sound; the receiving step, the customer's response is contained in a return e-mail from the customer, wherein the return e-mail includes a transaction number identifying the list of recommended rebalancing transactions; the customer's response is received on paper, wherein the paper includes an optical code for retrieving the list of recommended rebalancing transactions, and verification information for verifying the identity of the customer; the customer's response is received as a voice sound, wherein the voice sound is recognized using a voice recognition device; the customer's response is received through a wireless communications network; the customer's response is received from a financial Kiosk; the second unit transmits the alert message and the list of recommended rebalancing transactions via a first customer defined communications method; wherein the second unit automatically transmits the alert message and the list of recommended rebalancing transactions to the customer via a second customer-defined communications method if the second unit detects that the transmission via the first communications method was not successfully executed; the second unit receives, as the customer's response, a return e-mail from the customer, wherein the return e-mail includes a transaction number identifying the list of recommended rebalancing transactions; the second unit receives, as the customer's response, an optical code for

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retrieving the list of recommended rebalancing transactions, and verification information for verifying the identity of the customer; the second unit receives, as the customer's response, voice sounds which are recognized using a voice recognition device; the second unit receives the customer's response through a wireless communications network; or the customer's response from a financial Kiosk. Masand teaches financial methods and systems comprising the transmitting step is performed via a first customer-defined communications method (claim 2—p.4, 64-68); automatically transmitting the alert message and the list of recommended rebalancing transactions to the customer via a second customer-defined communications method if the step of transmitting via the first communications method was not successfully executed (claim 3-- p.4, 64-68); the customer's response constitutes performing a single action by the customer (claims 4 and 19-- p.4, 64-68); the single action comprises one of the following: pressing a button, touching a portion of a screen, or speaking a sound (claims 5 and 20-- p.4, 64-68); the receiving step, the customer's response is contained in a return e-mail from the customer, wherein the return e-mail includes a transaction number identifying the list of recommended rebalancing transactions (claim 10-- p.4, 64-68); the customer's response is received on paper, wherein the paper includes an optical code for retrieving the list of recommended rebalancing transactions, and verification information for verifying the identity of the customer (claim 11-- p.4, 64-68); the customer's response is received as a voice sound, wherein the voice sound is recognized using a voice recognition device (claim 12-- p.4, 64-68); the customer's response is received through a wireless communications network (claim 13-- p.4, 64-68); the customer's response is

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received from a financial Kiosk (claim 14-- p.4, 64-68); the second unit transmits the alert message and the list of recommended rebalancing transactions via a first customer defined communications method (claim 17-- p.4, 64-68); wherein the second unit automatically transmits the alert message and the list of recommended rebalancing transactions to the customer via a second customer-defined communications method if the second unit detects that the transmission via the first communications method was not successfully executed (claim 18-- p.4, 64-68); the second unit receives, as the customer's response, a return e-mail from the customer, wherein the return e-mail includes a transaction number identifying the list of recommended rebalancing transactions (claim 23-- p.4, 64-68); the second unit receives, as the customer's response, an optical code for retrieving the list of recommended rebalancing transactions, and verification information for verifying the identity of the customer (claim 24-- p.4, 64-68); the second unit receives, as the customer's response, voice sounds which are recognized using a voice recognition device (claim 25-- p.4, 64-68); the second unit receives the customer's response through a wireless communications network (claim 26-- p.4, 64-68); and the customer's response from a financial Kiosk (claim 27-- p.4, 64-68). It would have been obvious to one having ordinary skill in the art the time the invention was made to incorporate the transmitting step is performed via a first customer-defined communications method; automatically transmitting the alert message and the list of recommended rebalancing transactions to the customer via a second customer-defined communications method if the step of transmitting via the first communications method was not successfully executed; the customer's response

constitutes performing a single action by the customer; the single action comprises one of the following: pressing a button, touching a portion of a screen, or speaking a sound; the receiving step, the customer's response is contained in a return e-mail from the customer, wherein the return e-mail includes a transaction number identifying the list of recommended rebalancing transactions; the customer's response is received on paper, wherein the paper includes an optical code for retrieving the list of recommended rebalancing transactions, and verification information for verifying the identity of the customer; the customer's response is received as a voice sound, wherein the voice sound is recognized using a voice recognition device; the customer's response is received through a wireless communications network; the customer's response is received from a financial Kiosk; the second unit transmits the alert message and the list of recommended rebalancing transactions via a first customer defined communications method; wherein the second unit automatically transmits the alert message and the list of recommended rebalancing transactions to the customer via a second customer-defined communications method if the second unit detects that the transmission via the first communications method was not successfully executed; the second unit receives, as the customer's response, a return e-mail from the customer, wherein the return e-mail includes a transaction number identifying the list of recommended rebalancing transactions; the second unit receives, as the customer's response, an optical code for retrieving the list of recommended rebalancing transactions, and verification information for verifying the identity of the customer; the second unit receives, as the customer's response, voice sounds which are recognized using a voice recognition device; the

second unit receives the customer's response through a wireless communications network; and the customer's response from a financial Kiosk, as taught by Masand into the system and method disclosed by Shearer, to demonstrate that alternative forms of communication selected by the user may be used.

***Provisional Application Listed on PTO-892 form***

... If a copy of a provisional application listed on the bottom portion of the accompanying Notice of References Cited (PTO-892) form is not included with this Office action and the PTO-892 has been annotated to indicate that the copy was not readily available, it is because the copy could not be readily obtained when the Office action was mailed. Should applicant desire a copy of such a provisional application, applicant should promptly request the copy from the Office of Public Records (OPR) in accordance with 37 CFR 1.14(a)(1)(iv), paying the required fee under 37 CFR 1.19(b)(1). If a copy is ordered from OPR, the shortened statutory period for reply to this Office action will not be reset under MPEP § 710.06 unless applicant can demonstrate a substantial delay by the Office in fulfilling the order for the copy of the provisional application. Where the applicant has been notified on the PTO-892 that a copy of the provisional application is not readily available, the provision of MPEP § 707.05(a) that a copy of the cited reference will be automatically furnished without charge does not apply.


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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M Hamilton whose telephone number is (703) 306-5715. The examiner can normally be reached on Tuesday-Thursday (8:30-4:30).

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



LMH